

This Opinion is Not a
Precedent of the TTAB

Mailed: November 4, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Foil Boarding Company, Inc.

—
Serial No. 88622718
Serial No. 88622731
(Consolidated)

—
Kris Anderson and Mary Grace Rahm of Clark Partington,
for Foil Boarding Company, Inc.

Lauren D. Shinn, Trademark Examining Attorney, Law Office 128,
Travis Wheatley, Managing Attorney.

—
Before Taylor, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Foil Boarding Company, Inc. (“Applicant”) seeks registration on the Principal Register of the proposed standard character mark FOIL and the proposed stylized mark shown below

The image shows the word "FOIL" in a bold, italicized, sans-serif font. The letters are black and set against a white background. The font style is a condensed, slanted typeface.

for goods ultimately identified as “electric hydrofoil surfboards” in International Class 28.¹ The Trademark Examining Attorney has refused registration of both of Applicant’s proposed marks under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that they are “merely descriptive” of the goods identified in each application.²

When the Examining Attorney made the refusals final, Applicant appealed in both applications and requested reconsideration, which was denied. After the appeals were resumed and Applicant filed its briefs,³ the Board granted the Examining Attorney’s motion in each appeal to consolidate the two appeals. 9 TTABVUE 1 (Serial Nos. 88622718 and 88622731). The Examining Attorney subsequently filed a brief in both appeals. We affirm the two refusals to register.

¹ Application Serial No. 88622731 to register the proposed standard character mark and Application Serial No. 88622718 to register the proposed stylized mark were both filed on September 19, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the marks at least as early as November 1, 2017 and first use of the marks in commerce at least as early as September 1, 2019.

² Applicant does not argue that the stylization of its proposed mark in Application Serial No. 88622718 makes that proposed mark registrable on the Principal Register even if the word FOIL itself is merely descriptive. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016); *In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1487 (TTAB 2012). As discussed below, Applicant instead contends only that the word FOIL is not merely descriptive. Like Applicant, we will discuss its proposed standard character mark and its proposed stylized mark together in the singular.

³ Citations in this opinion to the briefs and other docket entries on appeal refer to TTABVUE, the Board’s online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant’s brief appears at 6 TTABVUE in each appeal. The Examining Attorney’s brief appears at 10 TTABVUE in each appeal. We will cite the briefs filed in the appeal in Application Serial No. 88622731.

I. Prosecution History and Record on Appeal⁴

We summarize below the identical prosecution histories of the two applications because they provide useful background to our analysis of the mere descriptiveness issue on appeal.

Applicant initially applied to register the proposed marks for goods identified as “electric hydrofoil surfboards; accessories for hydrofoil surfboards.” Applicant submitted the specimen of use shown below in both applications:



In Application Serial No. 88622718, Applicant described the specimen as the “[i]mage of electric hydrofoil surfboard with mark on hydrofoil and top of board.”

⁴ Citations in this opinion to the identical application records, including the requests for reconsideration and their denials, are to pages in the Trademark Status & Document Retrieval (“TSDR”) database of the United States Patent and Trademark Office (“USPTO”).

The Examining Attorney issued Office Actions refusing registration under Sections 2(d) and 2(e)(1) of the Trademark Act and raising informalities regarding the identification and classification of the goods.⁵ The Examining Attorney made of record a Wikipedia entry entitled “Foilboard;”⁶ a definition of “foil” from THE FREE DICTIONARY;⁷ a definition of “hydrofoil” from the COLLINS DICTIONARY;⁸ and third-party webpages displaying goods identified as “Foils” or “Foil Boards,” and as an “eFoil.”⁹

Both applications became abandoned, but Applicant filed petitions to revive them that included responses to the initial Office Actions. Applicant amended its identifications of goods to “electric hydrofoil surfboards,”¹⁰ and argued against the mere descriptiveness refusals. Applicant made of record Wikipedia entries entitled “Hydrofoil,” “Human-powered hydrofoil,” “Foil,” and “Foil (fluid mechanics);”¹¹ a definition of “foil” from the MERRIAM-WEBSTER DICTIONARY;¹² pages from its website

⁵ The Examining Attorney ultimately withdrew the Section 2(d) refusals in both applications, May 24, 2021 Denials of Requests for Reconsideration at TSDR 1, so we will not address the subsequent prosecution histories as they pertain to the Section 2(d) refusals.

⁶ December 31, 2019 Office Actions at TSDR 14-15.

⁷ *Id.* at TSDR 16-22.

⁸ *Id.* at TSDR 23-27.

⁹ *Id.* at TSDR 28-46.

¹⁰ July 13, 2020 Petitions to Revive at TSDR 3.

¹¹ *Id.* at TSDR 12-21, 46-47, 53-55.

¹² *Id.* at TSDR 48-52.

at getfoil.com;¹³ an online article from the ORANGE COUNTY REGISTER (CA);¹⁴ and third-party webpages displaying various surfboards.¹⁵

After the applications were revived,¹⁶ the Examining Attorney issued Office Actions making final the mere descriptiveness refusals.¹⁷ The Examining Attorney made of record online articles and webpages discussing foilboards, hydrofoil boards, hydrofoils, and foil surfing.¹⁸

Applicant appealed the final refusals in both applications and filed requests for reconsideration in which it again submitted the evidence that it had made of record in response to the first Office Actions.¹⁹ The Examining Attorney denied the requests, and made of record additional online articles and webpages regarding foil and hydrofoil boards.²⁰

II. Mere Descriptiveness Refusal

A. Applicable Law

Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with

¹³ *Id.* at TSDR 22-32.

¹⁴ *Id.* at TSDR 33-41.

¹⁵ *Id.* at TSDR 42-45.

¹⁶ July 14, 2020 Notices of Revival at TSDR 1.

¹⁷ September 11, 2020 Final Office Actions at TSDR 1.

¹⁸ *Id.* at TSDR 2-26.

¹⁹ March 9, 2021 Requests for Reconsideration at TSDR 12-55. Applicant’s resubmission of evidence already in the record was unnecessary.

²⁰ May 24, 2021 Denials of Requests for Reconsideration at TSDR 2-16.

the goods of the applicant is merely descriptive . . . of them,” unless the mark has acquired distinctiveness under Section 2(f) of the Act, 15 U.S.C. § 1052(f).²¹ “A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services.” *In re Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (quoting *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018) (citing *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978)). “A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *Gyulay*, 3 USPQ2d at 1010).

“Whether a mark is merely descriptive is ‘evaluated in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use,’” *Fallon*, 2020 USPQ2d 11249, at *7 (quoting *Chamber of Commerce*, 102 USPQ2d at 1219) (internal quotation omitted), and “not in the abstract or on the basis of guesswork.” *Id.* (quoting *Fat Boys*, 118

²¹ Applicant does not claim that its proposed mark has acquired distinctiveness.

USPQ2d at 1513) (citing *Abcor Dev.*, 200 USPQ at 218)). “We ask ‘whether someone who knows what the goods and services are will understand the mark to convey information about them.’” *Id.* (quoting *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (internal quotation omitted)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *Id.* (citing *Fat Boys*, 118 USPQ2d at 1515).

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Id.* (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)). “These sources may include [w]ebsites, publications and use in labels, packages, or in advertising materials directed to the goods.” *Id.*, at *7-8 (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (internal quotation omitted)).

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services.” *Id.*, at *8 (quoting *Fat Boys*, 118 USPQ2d at 1513). “If such a showing is made, the burden of rebuttal shifts to the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513). “The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513).

B. Summary of Arguments

1. Applicant

Applicant begins by arguing that “it is clear the standard for descriptiveness requires a basis of significance and immediacy.” 6 TTABVUE 9. With respect to significance, Applicant argues that a descriptiveness refusal is proper “only when ‘the mark merely describes a *significant* characteristic of the goods.” *Id.* at 8 (emphasis in original). As to immediacy, Applicant argues that “[i]f a certain image of the Applicant’s goods does not immediately come to mind upon hearing or seeing the mark, then *some imagination* must be required to connect the mark to the goods.” *Id.* (emphasis in original).

Based on this claimed descriptiveness standard, Applicant argues that the word FOIL that comprises its proposed mark “is not unconditionally ‘defined as a hydrofoil,’” that there are over 30 other definitions of the word “foil,” “including a piece of metal that has been formed into a thin flexible sheet, as well as a type of ‘fencing sword,’ ‘a person or thing that gives contrast to another,’ and, when used in hunting, a scent obscuring the trail of a hunted animal,” *id.* at 10, and that within the fields of aerodynamics and fluid mechanics, “[f]oils are used in various contexts and there is more than one type of foil: there are Airfoils, Hydrofoils, and Parafoils.” *Id.* at 11.

Applicant argues that

[t]he definition of “Foil” the Examining Attorney confuses in this case is from the fields of aerodynamic and fluid mechanics. In these fields, the word “Foil” refers to “a solid object with a shape such that when placed in a moving fluid

[or gas] at a suitable angle of attack the lift (force generated perpendicular to the fluid flow) is substantially larger than the drag (force generated parallel to the fluid flow),” which generates a lift. . . “If the fluid is a gas, the foil is called an airfoil or aerofoil, and if the fluid is water the foil is called a hydrofoil.” . . . Hydrofoils are “a lifting surface, or foil, that operates in water.” Not all foils are hydrofoils.

Id. at 10-11 (citations omitted).

Applicant argues that its “goods are electrically-propelled-hydrofoil surfboards,” that its “product features a hand-crafted, carbon-fiber board uniquely shaped for performance, an electric motor, and Bluetooth technology,” and that “[w]hile a type of foil may be used as a part of Applicant’s goods, its incorporation does not render Applicant’s Mark descriptive.” *Id.* at 11. Applicant claims that “[t]he lack of descriptiveness here is best illustrated by the following analogy:

[A] drive chain is an integral part of what makes a bicycle work. Drive chains are used in various contexts and configurations and on more than just bicycles. While a bicycle drive chain may be a key characteristic of a bicycle, the word “drive chain” would hardly be considered descriptive of a bicycle.

Id. Applicant continues that “while a specific type of foil may be an integral part of making Applicant’s goods work, the mark ‘FOIL’ is not descriptive of Applicant’s goods” because “a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.” *Id.* (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1209.01(a)).

Applicant contends that its proposed mark “is at the very least suggestive” because the proposed “mark FOIL does not *immediately* convey information about Applicant’s product to potential consumers.” *Id.* (emphasis in original). Applicant

claims that consumers must engage in “a multi-stage reasoning process when encountering the mark FOIL” that consists of the following steps:

First, consumers must already know that FOIL refers not to a really thin piece of metal but to a particular solid object with a shape such that when placed in a moving fluid at a suitable angle of attack the lift is substantially larger than the drag. Second, the consumer must understand that a foil submerged in water is a hydrofoil. Third, the consumer must take their understanding of each of these terms, and their basic knowledge of hydrodynamic mechanics, and make a substantial leap to arrive at the conclusion that Applicant sells some sort of hydrofoil-related product. The applied-for mark requires thought, imagination, and a certain basis of knowledge to even come close to arriving at the Applicant’s goods, and thus is not primarily merely descriptive of Applicant’s goods.

Id. at 12.

Applicant argues alternatively that “[e]ven if Applicant’s Mark does describe a characteristic of Applicant’s goods—it does not describe a *significant* characteristic. Applicant’s [goods] include a hydrofoil, but the vital characteristic of Applicant’s product is not the board, Bluetooth or the hydrofoil—it’s the motor.” *Id.* (emphasis in original). According to Applicant, “[w]hile the hydrofoil is incorporated, the significant characteristic of Applicant’s goods is the electric motor.” *Id.*

Applicant also claims that “any ambiguity [regarding descriptiveness] should be resolved in Applicant’s favor, and, in view of the foregoing, Applicant’s mark should be approved for publication.” *Id.* at 14.

In the “Conclusion” section of its brief, Applicant argues that the “USPTO database contains several notable analogous registrations on the Principal Register for marks that are composed of or contain the term ‘foil,’” *id.*, an apparent reference

to the third-party registrations that the Examining Attorney cited as possible bars to registration of FOIL under Section 2(d) of the Trademark Act.²² *Id.* at 7 n.2. Applicant argues that “such registrations further support Applicant’s position against descriptiveness of its mark.” *Id.* at 14.

2. The Examining Attorney

The Examining Attorney responds that the “term ‘FOIL’ is defined as ‘[a] hydrofoil’ . . . which in turn is defined as both (1) ‘any of the winglike structures attached to the hull of some watercraft’ and (2) ‘a craft with [any of the winglike structures attached to the hull of some watercraft].” 10 TTABVUE 4 (citations omitted). According to the Examining Attorney, the “term ‘FOIL’ is thus merely descriptive as it pertains to ‘electric hydrofoil surfboards’ because this type of watercraft not only *features* a ‘FOIL’ – *i.e.*, a winglike structure attached to its hull – but also *is* a type of ‘FOIL’ in that it is a watercraft that features a ‘FOIL.’” *Id.* (citations omitted).

The Examining Attorney points to webpages that she claims show that “it is common for third parties in the applicant’s industry to use the term ‘FOIL’ to describe not only the winglike structure meant for attaching to the hull of a surfboard, but also the type of surfboard that features such a structure.” *Id.* She argues that this “evidence shows that third parties in the applicant’s industry frequently use the term ‘FOIL’ to modify the term ‘board’ to specify that the type of board being discussed has the quality of being a hydrofoil surfboard,” and that the “same evidence shows that

²² December 31, 2019 Office Actions at TSDR 1-13.

third parties also use the term ‘FOIL’ on its own as a synonym for ‘hydrofoil surfboard.’” *Id.* at 7. She concludes that “the evidence demonstrates that the applied-for marks squarely describe the goods at issue because the term ‘FOIL’ describes a feature of the identified goods.” *Id.* at 8.

The Examining Attorney also rejects Applicant’s several arguments regarding the various definitions of the word “foil,” as well as its analogy to the claimed lack of descriptiveness of the term “drive chain” with respect to bicycles. *Id.* at 8-11. In particular, the Examining Attorney argues that the “argument regarding the examining attorney’s reliance on one definition of many is unpersuasive because descriptiveness is considered in relation to the relevant goods,” and because Applicant “has not provided any evidence regarding the dominance of the definition upon which” she relies, *id.* at 9; that she is relying on the definition of “foil” in the nautical sense, *id.*; that Applicant’s argument regarding the “multi-stage reasoning process” applies the wrong test for descriptiveness,” *id.* at 10-11; and that a “foil” is “a crucial component of electric hydrofoil surfboards boards because these goods would not *be* electric hydrofoil surfboards if they did not feature a ‘FOIL.’” *Id.* at 11 (emphasis in original).

C. Analysis of Refusal

The goods identified in Applicant’s application are “electric hydrofoil surfboards.” Applicant acknowledges that “a specific type of foil may be an integral part of making [its] goods work.” 6 TTABVUE 11. That “specific type of foil” is a “hydrofoil,” which is “any of the winglike structures attached to the hull of some watercraft” and “a craft

with hydrofoils.”²³ We display below a portion of a page from Applicant’s website at getfoil.com illustrating the effect of the hydrofoil attached to the bottom of the surfboard in “making Applicant’s goods work,” *id.*, by lifting the surfboard out of the water as it moves forward under the power of an electric motor:



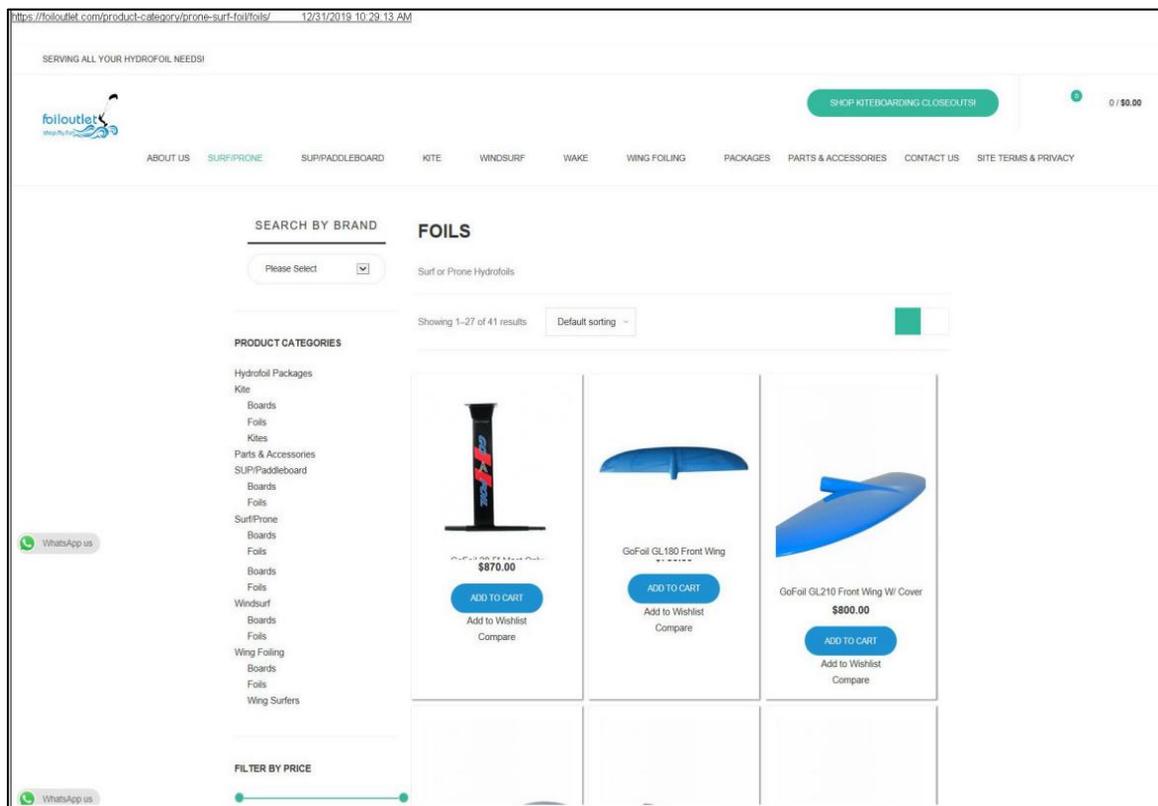
24

Consistent with Applicant’s acknowledgment that its “specific type of foil” is a hydrofoil, the record shows that in the context of the goods identified in the

²³ December 31, 2019 Office Actions at TSDR 24-25 (COLLINS DICTIONARY). The definition states that “at a certain speed the hull is lifted above the water and the craft skims along on the hydrofoils at great speeds.”

²⁴ July 13, 2020 Responses to Office Actions at TSDR 26. The Wikipedia entry entitled “Foilboard” describes a “foilboard” or “hydrofoil board” as “a surfboard with a hydrofoil that extends below the board into the water” whose “design causes the board to leave the surface of the water at various speeds.” December 31, 2019 Office Actions at TSDR 14.

application, the word “foil” is synonymous with the word “hydrofoil” in the identification of goods. The FREE DICTIONARY defines “foil” as follows: “(Nautical) A hydrofoil.”²⁵ A page from the website of foiloutlet.com shown below states that the company’s business is “Serving Your Hydrofoil Needs” and offers numerous products, including surfboards and surfboard foils, under the category of “Foils”:



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Two foils offered on the website are shown below:

²⁵ December 31, 2019 Office Actions at TSDR 16.

²⁶ *Id.* at TSDR 29.



SALE!

Slingshot Hover Glide FSurf V3 Surf
Foil

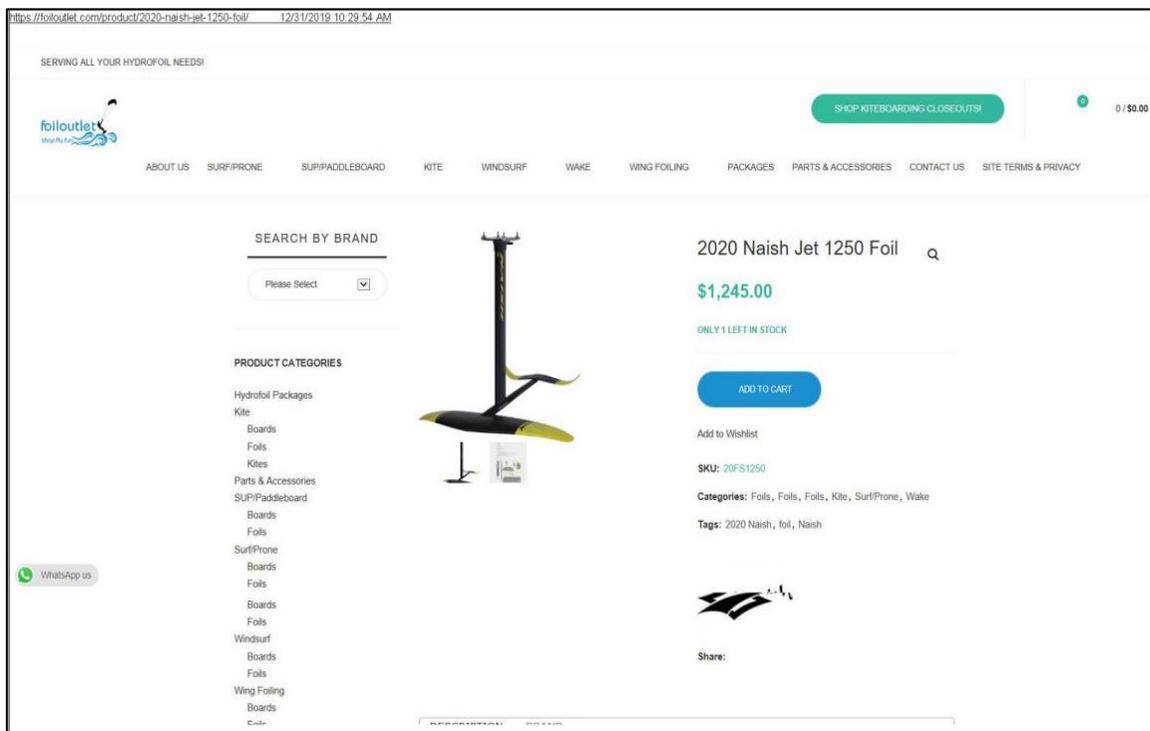
~~\$1,166.00~~ **\$1,049.00**

ADD TO CART

Add to Wishlist

Compare

27



https://foiloutlet.com/product/2020-naish-jet-1250-foil 12/31/2019 10:29:54 AM

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PRODUCT CATEGORIES

- Hydrofoil Packages
- Kite
 - Boards
 - Foils
 - Kites
- Parts & Accessories
- SUP/Paddleboard
 - Boards
 - Foils
- Surf/Prone
 - Boards
 - Foils
 - Boards
 - Foils
- Windsurf
 - Boards
 - Foils
- Wing Foiling
 - Boards

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2020 Naish Jet 1250 Foil

\$1,245.00

ONLY 1 LEFT IN STOCK

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SKU: 20FS1250

Categories: Foils, Foils, Foils, Kite, Surf/Prone, Wake

Tags: 2020 Naish, foil, Naish

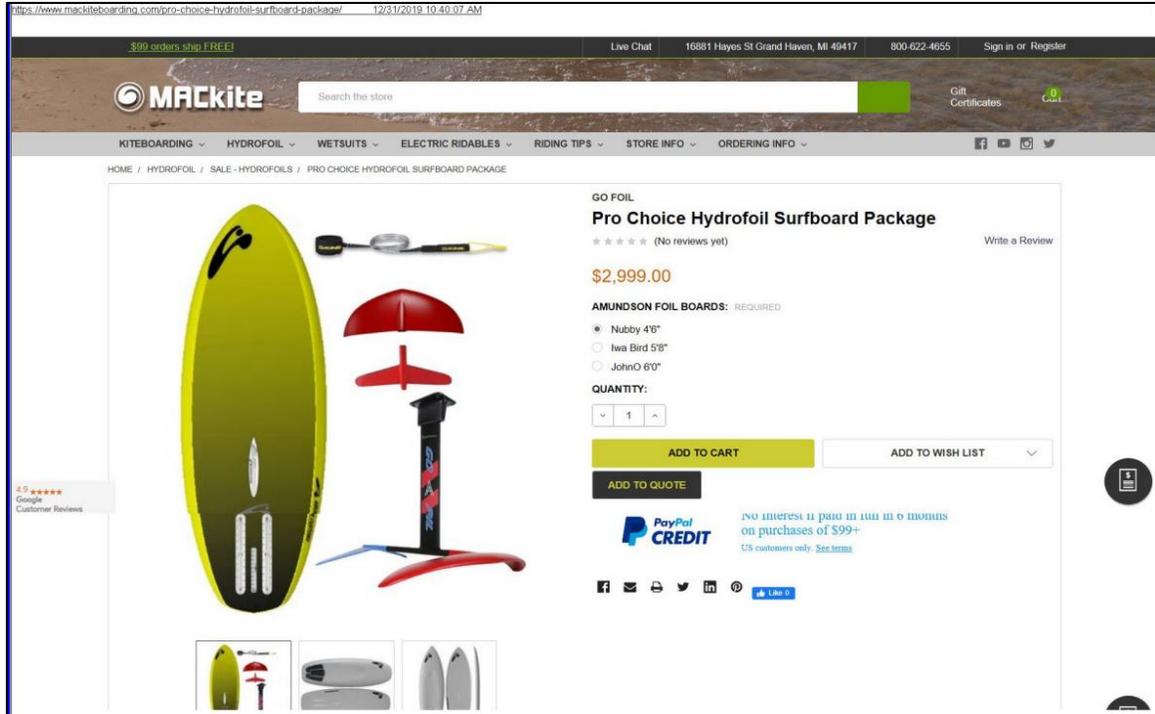
Share:

28

²⁷ *Id.* at TSDR 31.

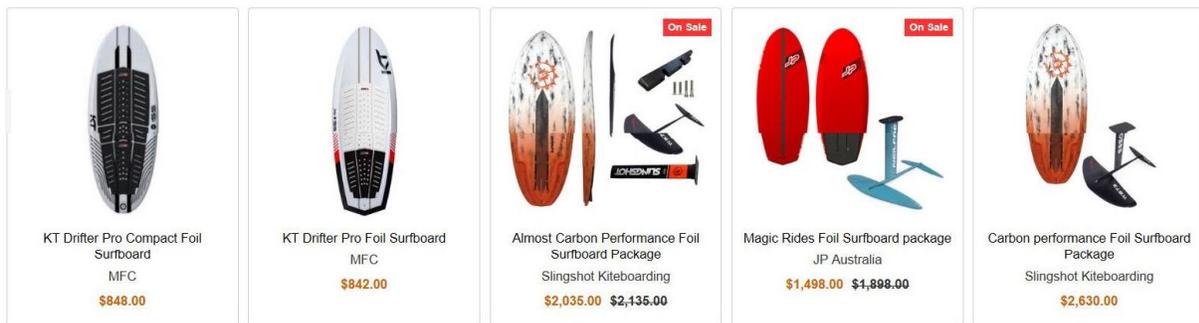
²⁸ *Id.* at TSDR 33. Text accompanying this product display states that the product is “at the forefront of foiling” and “sets a new performance standard for surf and SUP foiling.” *Id.* at TSDR 34.

The website at mackiteboarding.com displays a “Pro Choice Hydrofoil Surfboard Package” for “Amundson Foil Boards”:



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The website also offers other “Foil Surfboards” and “Foil Surfboard” packages:



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The website at techwewant.com reviews the “Lift eFoil Electric Hydrofoil Surfboard” and discusses the product’s producer as follows:

²⁹ *Id.* at TSDR 36.

³⁰ *Id.* at TSDR 40.

Lift Foils is the first company to produce an electric hydrofoil that is already shipping to customers worldwide. We got a chance to take it for a ride and experience the board for the first time.



³¹

An article in the ORANGE COUNTY REGISTER made of record by Applicant entitled “Foil surfing 101: What is it? How safe is it?” states that “Foil surfing – or foilboarding or hydrofoiling or just foiling – is an increasingly common sight at beaches in Southern California and around the world.”³² The article explains “how this strange looking contraption works: the wing-like foil under the board cutting through the water, lifting the board into the air, while the wave pushes the rider forward.”³³ The article includes the following textual and visual explanation of “How a foil board works”:

³¹ *Id.* at TSDR 41.

³² July 13, 2020 Responses to Office Actions at TSDR 33-34.

³³ *Id.*

How a foil board works

A foil board is a surfboard with a hydrofoil that extends into the water and allows the surfer to ride the smallest of waves. Laird Hamilton was one of the first watermen to attach a foil to a surfboard.

This design causes the board to leave the surface of the water at various speeds and allows the rider to glide with the moving wave by harnessing the kinetic energy with the underwater swell.

Lean on your back foot to tilt the wing up and increase lift.

Lean on your front foot to tilt the wing down and reduce lift.

Stabilizer wing
Mast
Fuselage
Front wing

The hydrofoil works like an airplane wing. With the slightest of swell energy, the foil is able to create lift, allowing the surfer to catch the smallest of waves effortlessly.

Lift

Foil

Swell energy

Source: Surfertoday.com

JEFF GOERTZEN, SCNG

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³⁴ *Id.* at TSDR 33.

Applicant also made of record webpages displaying surfboards identified as “foil boards”:



The website at pacificsurf.org contains a section captioned “Different Types of Surfboards and Surfing.”³⁶ The website defines “[a] foilboard or hydrofoil board” as “a surfboard with a hydrofoil that extends below the board into the water” whose “design causes the board to leave the surface of the water at various speeds.”³⁷ The website at blog.3radkids.com discusses “Choosing the Right Hydrofoil or Foil Board for You.”³⁸

³⁵ *Id.* at TSDR 42.

³⁶ September 11, 2020 Final Office Actions at TSDR 5.

³⁷ *Id.* at TSDR 7. The websites at surfstationstore.com and wavearcade.com similar define a foilboard. *Id.* at TSDR 9, 12.

³⁸ May 24, 2020 Denials of Requests for Reconsideration at TSDR 9-12.

Many of the foil boards discussed and displayed above rely on the kinetic energy of swells to function, but the record shows that surfboards described as “foil boards” may also use electric power to generate forward motion and lift in flat water. The website at wavearcade.com states that “[t]oday, you can even find motorized hydrofoil boards powered by an electric propeller that’s controlled with a remote.”³⁹ The website at electricboardingco.com discusses the development of its “classic foil board,” which it describes as “The Original Electric HydroFoil Board.”⁴⁰ The website at newatlas.com discusses the introduction by Waydoo of “a relatively cheap electric foil board called the Flyer, which went on sale late in 2019.”⁴¹ The website at e-foilhawaii.com “offer[s] electric foil board rentals and lessons,” describes an “[e]lectric foil board or hydrofoil board” as “a surfboard with a hydrofoil that extends below the board into the water,” and states that “[s]urfing on an electric foil board is like gliding above the water.”⁴²

The record as a whole shows that the Examining Attorney established a prima facie case that the proposed mark FOIL is highly descriptive of a feature of “electric hydrofoil surfboards,” namely, that they contain the component known as a “foil.”⁴³ The establishment of a prima facie case shifted the burden of rebuttal to Applicant.

³⁹ September 11, 2020 Final Office Actions at TSDR 13.

⁴⁰ *Id.* at TSDR 24.

⁴¹ May 24, 2021 Denials of Requests for Reconsideration at TSDR 3.

⁴² *Id.* at TSDR 16.

⁴³ We agree with the Examining Attorney that “the term ‘FOIL’ is a synonym for the genus of the identified goods,” 10 TTABVUE 7, but the issue of the possible genericness of Applicant’s proposed mark is not before us on this appeal.

Fallon, 2020 USPQ2d 11249, at *8. For the reasons discussed below, we find that Applicant failed to carry its burden.

Applicant's arguments that there are multiple meanings of the word "foil," 6 TTABVUE 10, that the meaning relied on by the Examining Attorney "was far from the predominant definition," *id.*, and that "consumers will undergo a multi-stage reasoning process when encountering the word FOIL" and must "make a substantial leap to arrive at the conclusion that Applicant sells some sort of hydrofoil-related products," *id.* at 12, reflect an all-too-common misunderstanding of the mere descriptiveness analysis.

As the Board and the Federal Circuit have repeatedly explained, the applicable "test is not whether someone encountering the mark alone could guess what the goods are. As noted above, we evaluate whether someone who knows what the goods are will understand the mark to convey information about them." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (rejecting the argument that the proposed mark RECOIL was not merely descriptive of medical and athletic cohesive tape "because RECOIL does not have one meaning, [and] consumers must use a multi-stage reasoning process to associate RECOIL with a property of medical or athletic cohesive tape") (citing *DuoProSS*, 103 USPQ2d at 1757). The fact that FOIL "may have other meanings in different contexts is not controlling." *Canine Caviar*, 126 USPQ2d at 1598. "[I]t is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *Mueller Sports Med.*, 126 USPQ2d at 1590. Someone who knows that the goods are "electric

hydrofoil surfboards” will understand the proposed mark FOIL to immediately convey information regarding a feature of the goods, namely, that they contain the component known as a “foil.” *See id.*

Applicant’s fallback argument that even if its proposed mark describes “a characteristic of Applicant’s goods—it does not describe a *significant* characteristic,” 6 TTABVUE 12 (emphasis in original), and its related argument that “the significant characteristic of Applicant’s goods is the electric motor,” *id.*, similarly misapprehend the test for mere descriptiveness. There is no requirement that a proposed mark describe **the** most significant feature of the involved goods (assuming that such a feature could be identified). Instead, “it is enough if it describes **one** significant attribute, function or property of the goods.” *Fat Boys*, 118 USPQ2d at 1513 (emphasis added). The fact that Applicant’s goods feature the component known as a “foil” is clearly at least a significant attribute, function or property of the goods; indeed, we agree with the Examining Attorney that the “FOIL’ is a crucial component of electric hydrofoil surfboards boards because these goods would not *be* electric hydrofoil surfboards if they did not feature a ‘FOIL.’” 10 TTABVUE 11 (emphasis in original).

Applicant also cannot rely on “several notable analogous registrations on the Principal Register for marks that are comprised of or contain the term ‘Foil’” as “further support [for] Applicant’s position against descriptiveness of its mark.” 6 TTABVUE 14. “[T]he fact that third-party registrations exist for marks allegedly similar to Applicant’s Proposed Marks is not conclusive on the issue of descriptiveness

or genericness.” *In re The Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at *22 (TTAB 2021) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). “Marks that are merely descriptive or generic do not become registrable simply because other seemingly similar marks appear on the register.” *Id.* (citing *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977)). Moreover, the referenced third-party registrations cited by the Examining Attorney in support of the initial Section 2(d) refusal do not show that FOIL is inherently distinctive for the goods identified in Applicant’s application. The word FOIL is disclaimed in the registrations of GO FOIL for “Hydro Foil water sports equipment goods, namely, hydro foils for attachment to surf boards, kite boards and stand up paddle boards,”⁴⁴ and FOIL STRONGBOX for “Accessories for surfboards, stand up paddle boards, windsurf boards, hydrofoil boards, namely, board inserts for installation.”⁴⁵ The registration of FOILFLUKES for an “Accessory for hydrofoil surfboards, stand-up paddle boards, and kiteboards in the nature of a bolt on tail system that provides forward movement in the water when moved up and down and attaches to hydrofoil surfboards, stand-up paddle board, and kiteboards” is on the Supplemental Register.⁴⁶ The registrations of I-FOIL for “foilboards and hydrofoil boards,”⁴⁷ and VEFOIL for “electric hydrofoil surfboards,”⁴⁸ both involve unitary

⁴⁴ December 31, 2019 Office Actions at TSDR 2-3 (Registration No. 5127620).

⁴⁵ *Id.* at TSDR 7-8 (Registration No. 5818526).

⁴⁶ *Id.* at TSDR 11-13 (Registration No. 5853687).

⁴⁷ *Id.* at TSDR 4-6 (Registration No. 5604802).

⁴⁸ *Id.* at TSDR 9-10 (Registration No. 5820060).

marks and the fact that the term FOIL has not been disclaimed does not support Applicant's claim that FOIL is inherently distinctive and registrable as its mark. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (a unitary mark's "elements are inseparable" and not subject to disclaimer requirements). All of "these registered marks present dissimilar circumstances" to those here, *Consumer Protection Firm*, 2021 USPQ2d 238, at *22, in which Applicant seeks Principal Register registrations of FOIL alone.

Applicant's argument of last resort is that "Applicant's mark, at worst, straddles the cusp between being suggestive and merely descriptive, [and] a proper balancing of the doubts at hand favors publication of Applicant's mark for opposition." 6 TTABVue 14. "While we must resolve doubt for Applicant, we have no doubt that (based on the entire record) the designation [FOIL] immediately conveys information to the relevant target audience," purchasers of "electric hydrofoil surfboards," that the identified goods feature the component known as a "foil." *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *11 (TTAB 2020).

The record as a whole establishes that Applicant's proposed mark FOIL is "merely descriptive" of a feature of "electric hydrofoil surfboards" within the meaning of Section 2(e)(1) of the Trademark Act, and is thus unregistrable on the Principal Register in the absence of a showing of acquired distinctiveness under Section 2(f) of the Trademark Act.

Decision: The refusal to register is affirmed in each appeal.